UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,955	09/17/2003	Thomas A. Todd	P03927	8347

28548 7590 09/24/2007

STONEMAN LAW OFFICES, LTD
3113 NORTH 3RD STREET
PHOENIX, AZ 85012

EXAMINER	
TOOMER, CEPHIA D	
ART UNIT	**PAPER NUMBER**
1714	

MAIL DATE	DELIVERY MODE
09/24/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/665,955	TODD ET AL.	
	Examiner	Art Unit	
	Cephia D. Toomer	1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 May 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-70* is/are pending in the application.

4a) Of the above claim(s) *61-70* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-60* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This Office action is in response to the amendment filed May 28, 2007 in which claims 1, 7, 15, 19, 31, 35, 38-46 and 48-55 were amended.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1, 7, 19, 55 and their dependents are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are rejected because the terms comprehensive fuel additive is not understood. In the original claims, applicant recited a user-friendly effective additive. Applicant deleted those terms and replaced them with "comprehensive fuel additive." The examiner has reviewed the specification and finds that any recitation regarding a comprehensive fuel additive refers to the combination of all of the claimed components and not to an individual component.

3. Claims 15, 31, 36-38,40-43 and 46-53 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15 contains the trademark/trade names DCI 6A; DMA 558; and AO 22. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the

requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a corrosion inhibitor, a detergent, a fuel stabilizing additive and a lubricity additive and, accordingly, the identification/description is indefinite.

Claim 31 contains the trademark/trade names T9312; DCI 6A; AROL 50; DMA 558 and OLI 5015. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a biocide, a corrosion inhibitor, a water managing additive; a detergent; a solvent; a fuel stabilizer and a lubricity enhancer and, accordingly, the identification/description is indefinite.

Claims 36 and 46 contain the trademark/trade name DCI products, HITEC 580, BIOBOR JF and ONDEO-NALCO 5403. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe corrosion inhibitors and, accordingly, the identification/description is indefinite.

Claim 37 contains the trademark/trade name DMA 451. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe water managing additive and, accordingly, the identification/description is indefinite.

Claim 38 contains the trademark/trade name DMA products. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a detergent and, accordingly, the identification/description is indefinite.

Claim 40 contains the trademark/trade name AO 22 and AO series. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a fuel stabilizer and, accordingly, the identification/description is indefinite.

Claim 41 contains the trademark/trade name ONDEO-NALCO 303MC; and BIOBOR JF. Where a trademark or trade name is used in a claim as a limitation to

identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a biocide and, accordingly, the identification/description is indefinite.

Claim 42 contains the trademark/trade name DCI products and ONDEO-NALCO 5403. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a lubricity additive and, accordingly, the identification/description is indefinite.

Claim 43 contains the trademark/trade name HITEC 3023. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular

material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a combustion modifier and, accordingly, the identification/description is indefinite.

Claim 47 contains trademarks/trade names for components a-e. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademarks/trade names are used to identify/describe water managing additive and, accordingly, the identification/description is indefinite.

Claim 48 contains the trademarks/trade names for components a)-i). Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35

U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademarks/trade names are used to identify/describe a detergent and, accordingly, the identification/description is indefinite.

Claim 49 contains the trademark/trade name AROL 50 and HISOL 100. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a solvent and, accordingly, the identification/description is indefinite.

Claim 50 contains the trademark/trade name DMA 558 AND DMA SERIES PRODUCTS. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade

name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a fuel stabilizer and, accordingly, the identification/description is indefinite.

Claim 51 contains the trademarks/trade names for components a), b), and d)-f) Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a biocide and, accordingly, the identification/description is indefinite.

Claim 52 contains trademarks/trade names for components a)-g). Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used

properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a lubricity additive and, accordingly, the identification/description is indefinite.

Claim 53 contains the trademark/trade name HITEC 3023 and ALKEN EVEN FLO 910. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a combustion modifier and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-14, 19-30, 35, 37-42, 44, 45, 47-52 and 54-60 rejected under 35 U.S.C. 103(a) as being unpatentable over Cunningham (US 5,279,626).

Cunningham teaches a method for enhancing a fuel additive package so as to improve the shelf-life of the package wherein the package comprises a detergent/dispersant (applicant's fuel stabilizer/detergent), a demulsifier (applicant's water managing action additive) and admixing a solvent stabilizer composition (satisfies applicant's biocide, combustion boosting additive, water managing additive, solvent and low temperature flow improver) (see abstract). The solvent stabilizer is formed from at least one aromatic hydrocarbon solvent and at least one alkyl or cycloalkyl alcohol. Examples of the aromatic solvent include benzene and alkyl substituted benzene or mixtures thereof. Examples of the alcohol solvents include C_2-C_8 alcohols such as ethanol, propanol and mixtures thereof (see col. 2, lines 17-38). The detergent/dispersant is the reaction product of a polyamine and at least one acyclic hydrocarbyl-substituted succinic acylating agent (see col. 3, lines 40-43). The demulsifier includes compounds such as organic sulfonates, polyoxyalkylene glycols (see col. 5, lines 54-57). Other components may be used in the additive package including oxidation inhibitors, corrosion inhibitors, emission control additives (combustion modifying additive), lubricity additives, biocides and octane or cetane improves (combustion boosting additives) (see col. 5, lines 64-68). Cunningham teaches the limitations of the claims other than the differences that are discussed below.

In the first aspect, Cunningham differs from the claims in that he does not specifically teach a composition wherein all the components are present. However, no

unobviousness is seen in this difference because Cunningham teaches all of the claimed components and he teaches that they may be combined to produce an additive package.

In the second aspect, Cunningham differs from the claims in that he does not specifically teach the claimed proportions. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to optimize the proportions of the additive components through routine experimentation for the best results. As to optimization results, a patent will not be granted based upon the optimization of result effective variables when the optimization is obtained through routine experimentation unless there is a showing of unexpected results which properly rebuts the *prima facie* case of obviousness. See *In re Boesch,* 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980). See also *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936-37 (Fed. Cir. 1990), and *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

6. Applicant's arguments have been fully considered but they are not persuasive.

Applicant argues that the declaration of Edward R. Eaton is sufficient to overcome the rejection under 35 U.S.C. 112, second paragraph regarding the use of trademark/tradenames in the claims.

The examiner respectfully disagrees. The MPEP is very specific regarding the use of a trademark or trade name in a claim. If the trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. The claim scope is uncertain since the trademark or trade name cannot be used properly to

identify any particular material or product. In fact, the value of a trademark would be lost to the extent that it became descriptive of a product, rather than used as an identification of a source or origin of a product. See MPEP 2173.05(u).

Applicant argues that the examiner has not set forth a prima facie case of obviousness because Cunningham does not explicitly set forth Applicant's eight-function fuel additive. Applicant argues that Cunningham does not teach or suggest useful finished formulae for treating the entire spectrum of fuel quality problems.

The rationale which supports the examiner's conclusion that it would have been obvious to combine the components is that all of the claimed components are taught by the prior art and one skilled in the art would have combined the elements as claimed, with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art at the time of the invention.

While Cunningham is concerned with enhancing shelf-life stability for long-term storage, it is well settled that the prior art reason for combining the components may be different from Applicant's reason for combining. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. The additives set forth in the present invention are found within the four corners of Cunningham. Cunningham teaches that all of the additives may be present in his additive package.

Applicant argues that he is not dealing with a result effective variable because the present invention is dealing with a completely different problem.

Applicant is using conventional fuel additives wherein is it common practice to optimize the proportions of the additives. For example, in order to determine the amount of corrosion inhibitor that is effective to prevent corrosion in the combustion engine, the skilled artisan must experiment with the amount of inhibitor required to prevent or reduce corrosion. Therefore, the proportion required to prevent or inhibit corrosion is a result effective variable. The skilled artisan recognizes that experimentation is required to obtain the best results.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia D. Toomer whose telephone number is 571-272-1126. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Cephia D. Toomer
Primary Examiner
Art Unit 1714

10665955\20070916